

REMARKS

In the last Office Action mailed May 15, 2006, the Examiner objected to the specification for failing to provide antecedent basis for claimed subject matter; rejected claims 18, 23, 50, 55, 69, 70, 76, 77, and 87 under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement; rejected claims 18, 23, 50, 55, 69, 70, 76, 77, and 87 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention; rejected claims 18-20, 22, 26, 50-59, 69, 76, and 87 under 35 U.S.C. § 103(a) as being unpatentable by U.S. Patent Publication No. 2002/0002590 to *King et al.* ("*King*") in view of U.S. Patent No. 5,341,505 to *Whitehouse*;¹ rejected claims 23-25, 27, 55-57, 59, 70, 77, 79-82, 84-86, 88, and 90-91 under 35 U.S.C. § 102(e) as being anticipated by *King*; and rejected claims 83 and 89 under 35 U.S.C. § 103(a) as being unpatentable in view of *Whitehouse*.

By this Amendment, Applicants amend claims 18, 23, 50, 55, 69, 70, 76, and 77 to further define the invention. Support for Applicants' claim amendments can be found, for example, in the specification on pages 15-20. Claims 79, 81, and 86 have been

¹ Although the Examiner has listed claims 21 and 53, 87, 26 and 58, and 83 and 89 separately in the Office Action, Applicants has addressed these in the section under 103(a) with the rest of the claims. Furthermore, Applicants note that claims 55-57 and 59 were shown rejected under the 103(a) section, however they were addressed in the 102(e) rejection. Therefore, Applicants have addressed these claims with regard to the 102(e) rejection.

amended to incorporate the subject matter of claims 80, 82, and 87, respectively.

Applicants have also canceled claims 80, 82, and 87. By this Amendment, claims 18-28, 50-59, 60-70, 76-77, 79, 81, 83-86, and 88-91 remain pending in this application.

I. Objection to the Specification

The Examiner objected to the specification because the terms “seven digit zip code” and “alias” are not found in the specification. Although Applicants disagree with the Examiner’s assertions, Applicants have amended the claims containing these terms and since these terms are no longer claimed, the objection is moot.

II. Rejection of claims under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 18, 23, 50, 55, 69, 70, 76, 77, and 87 under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Although Applicants disagree with the Examiner’s assertions, Applicants have amended the claims containing these terms, and since the terms “seven-digit zip code” and “alias” are no longer claimed, the rejection is moot. Therefore, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. § 112, first paragraph rejection.

III. Rejection of claims under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 18, 23, 50, 55, 69, 70, 76, 77, and 87 under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Applicants regards as their invention. Although Applicants disagree with the Examiner’s assertions, Applicants have amended the claims containing these terms and since the terms “seven-digit zip code” and “alias” are no

longer claimed, the rejection is moot. Therefore, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. § 112, second paragraph rejection.

IV. Rejection of claims 18-20, 22, 26, 50-54, 56-59, 69, 76, 87 under 35 U.S.C. § 103(a)

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143. Applicants submit that the Examiner cannot establish a *prima facie* case of obviousness because the cited references fail to teach or suggest each and every limitation of the claims. See M.P.E.P. § 2143.01.

As amended, independent claims 18, 50 , 69 , 76, and 79, recite, *inter alia*:

receiving the message directed to the user with the electronic account, where the message includes an electronic address associated with the user's electronic account and a non-standardized physical address of the user;
determining a standardized physical address of the user from the electronic address using an address database

The Examiner relies on *King* citing page 2, paragraphs 22-23 for an alleged teaching of the above-recited claim limitations. Applicants respectfully disagree.

King describes a system for routing emails based on the recipient's physical address. (*King*, Abstract.) The *King* system allows a sender to manually enter a physical address of a recipient or choose a physical address of the recipient, as well as entering an email address of the recipient to send a

message. (*See Id.* at [018].) If the sender does not know the recipient's physical address, then the physical address can be determined by "searching based on the recipient's telephone number, zip code, state, or by any other information that is useful in the event that the sender does not know the physical address of the recipient." (*See Id.* at [0022].) Therefore in the *King* system, only if the physical address is not known does the system look up the physical address of the recipient. As a result, *King* does not teach or disclose "where the message includes an electronic address associated with the user's electronic account and a non-standardized physical address of the user; [and] determining a standardized physical address of the user from the electronic address using an address database." By contrast, in the *King* system, if the message includes a physical address, a physical address does not have to be determined. (*See Id.*)

Therefore, *King* fails to teach or suggest "receiving the message directed to the user with the electronic account, where the message includes an electronic address associated with the user's electronic account and a non-standardized physical address of the user; [and] determining a standardized physical address of the user from the electronic address using an address database," as recited in claims 18, 50, 69, 76, and 79. *Whitehouse*, cited for an alleged teaching of "five-digit zip code" does not overcome the deficiencies of *King*.

Accordingly, *King* and *Whitehouse*, taken alone or in any proper combination, do not teach or suggest each and every feature recited in Applicants' amended independent claims 18, 50, 69, 76, and 79, and, therefore, cannot support a rejection of

these claims or dependent claims 19-20, 22, 26, 51-54, and 58² under 35 U.S.C.

§ 103(a). The rejection of claim 87 is moot, since this claim was cancelled.

Accordingly, reconsideration and withdrawal of the rejection is respectfully requested and deemed appropriate.

V. Rejection of claims 23-25, 27, 55-57, 59, 70, 77, 79-82, 84-86, 88, and 90-91 under 35 U.S.C. § 102(e)

In order for *King* to anticipate Applicants' claimed invention under 35 U.S.C. §102(e), every element of the claim at issue must be found, either expressly described or under principles of inherency, in the reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)). *King* fails to anticipate independent claims 23, 55, 70, 77, 79, 81, 86, and 88 because *King* does not disclose, expressly or otherwise, every feature recited in these claims.

Claims 23, 55, 70, and 77

As amended, independent claims 23, 55, 70, and 70, recite, *inter alia*:

receiving the message directed to the user with the electronic account, where the message includes a non-standardized electronic address of the user and a physical address of the user;
determining a standardized electronic address of the user from the physical address using an address database

King discloses that "the recipient's physical address can be determined by searching based on the recipient's telephone number, zip code, state, or by any other

² Applicants again note that claims 55-57 and 59 were shown rejected under the 103(a) section, however

information that is useful,” not determining “a standardized electronic address of the user from the physical address using an address database,” as recited in claims 23, 55, 70, and 77. Therefore, only if a physical address is not known does *King* attempt to determine it. *King* does not contain any disclosure of “determining a standardized electronic address of the user,” as recited in claims 23, 55, 70, and 77. In *King*, the system “transmits an e-mail addressed to the recipient’s physical address.” (See *id.* at 0018.) A “conventional e-mail address can also be entered to send a message or to send a carbon copy of the message.” (See *id.* at 0018].). In *King*, the “electronic address” is never determined, it is entered by the user only if they want a carbon copy of the message. (See *Id.*) *King* states that “a database would be maintained . . . in order the populate the address line of an e-mail” because the message is sent to the recipient’s physical address. (See *id.* at [0018] and [0022].) Therefore, the physical address is determined, if any, not the “standardized electronic address of the user,” as recited in claims 23, 55, 70, and 77.

Therefore, *King* fails to teach or suggest “determining a standardized electronic address of the user from the physical address using an address database,” as recited in claims 23, 55, 70, and 77. Applicants, therefore, respectfully request the Examiner to withdraw the 35 U.S.C. § 102(e) rejection of independent claims 23, 55, 70, and 77, as well as claims 24-25, 27, 56-57, and 59, at least due to their dependence from claims 23, 55, 70, and 77, respectively. The rejections of claims 80 and 82 are moot, since these claims were cancelled.

Claims 81, 88

they were addressed in the 102(e) rejection. Therefore, applicants have addressed these claims with

Independent claims 81 and 88, as amended, recite, *inter alia*:

receiving the message directed to the user with the electronic account, where the message includes a non-standardized electronic address and a physical address of the user;

determine a delivery point identification key using the physical address, wherein the delivery point identification key points to a location in an address database, the location associated with a standardized electronic address of the user.

The Examiner asserts *King* teaches the above-recited claims limitations by citing page 2, paragraph 22 of *King*. Applicants respectfully disagree.

As discussed above, in the *King* system, only if the physical address is not known does the system look up the physical address of the recipient. (See *Id.* at [0022].) *King* never even determines a “delivery point identification key,” as recited in claims 81 and 88. By contrast, in the *King* system, if the message includes a physical address, a physical address never has to be determined, much less a “delivery point identification value.” Therefore, *King* fails to teach or suggest “receiving the message directed to the user with the electronic account, where the message includes a non-standardized electronic address and a physical address of the user; [and] determining a delivery point identification key using the physical address, wherein the delivery point identification key points to a location in an address database, the location associated with a standardized electronic address of the user,” as recited in claims 81 and 88.

Applicants, therefore, respectfully request the Examiner to withdraw the 35 U.S.C. § 102(e) rejection of independent claims 81 and 88, as well as claims 84-85, 90-91 at least due to their dependence from claims 81 and 88, respectively.

Claims 79 and 86

regard to the 102(e) rejection.

Independent claims 79 and 86, recite, *inter alia*:

receiving the message directed to the user with the electronic account, where the message includes an electronic address associated with the user's electronic account and a non-standardized physical address of the user;

determining a delivery point identification key using the electronic address, wherein the delivery point identification key points to a location in an address database, the location associated with a standardized physical address of the user

As discussed above, *King* does not determine any "delivery point identification value," much less "determining a delivery point identification key using the electronic address," as recited in claims 79 and 86. Furthermore, in *King*, only if the physical address is not known does the system look up the physical address of the recipient. (See *id.* at [0022].) Therefore, if the message includes a physical address, nothing else needs to be determined. As a result, *King* fails to teach or suggest "receiving the message directed to the user with the electronic account, where the message includes an electronic address associated with the user's electronic account and a non-standardized physical address of the user; [and] determining a delivery point identification key using the electronic address, wherein the delivery point identification key points to a location in an address database, the location associated with a standardized physical address of the user," as recited in claims 79 and 86. Applicants, therefore, respectfully request the Examiner to withdraw the 35 U.S.C. § 102(e) rejection of independent claims 79 and 86.

VI. Rejection of claims 83 and 89 under 35 U.S.C. § 103(a)

As discussed above, *King* fails to teach or suggest "receiving the message directed to the user with the electronic account, where the message includes a non-

standardized electronic address and a physical address of the user; [and] determine a delivery point identification key using the physical address, wherein the delivery point identification key points to a location in an address database, the location associated with a standardized electronic address of the user," as recited in claims 81 and 88.

Whitehouse, cited for an alleged teaching of "five-digit zip code" does not overcome the deficiencies of *King*. Accordingly, *King* and *Whitehouse*, taken alone or in any proper combination, do not teach or suggest each and every feature recited in Applicants' amended independent claims 81 and 88, and, therefore, cannot support a rejection of these claims or dependent claims 83 and 89 under 35 U.S.C. § 103(a). Accordingly, reconsideration and withdrawal of the rejection is respectfully requested and deemed appropriate.

Conclusion

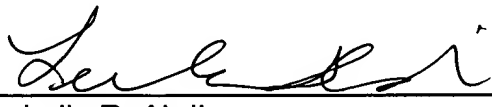
Applicants respectfully request reconsideration of the application, withdrawal of the claim rejections, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 15, 2006

By: 
Leila R. Abdi
Reg. No. 52,399